

REMARKS

Applicant respectfully requests reconsideration of this application in view of the foregoing amendments and these remarks.

I. Disposition of the Claims

Claims 1 and 17-24 are currently amended. Support for the revisions in question can be found throughout the specification, including in the original claims. No new matter is added.

Upon entry of this response, claims 1-24 will be pending, with claims 2-16 withdrawn. Thus, claims 1 and 17-24 would be subject to examination on the merits.

As revised, claims 1 and 17-24 omit an “about” qualifier from recitations of molecular-weight and isoelectric-point values. In order that the record is clear on the scope of the present claims, Applicant proffers the accompanying Rule 132 declaration by the inventor, Robert H. Getzenberg, who details the art-recognized meaning of claim terminology relating to molecular-weight and isoelectric-point values.

More specifically, Dr. Getzenberg underscores a common understanding in the art, namely, that molecular-weights and isoelectric-points can vary slightly for a particular protein. As he attests in paragraph 6, these variations are caused by many factors, including post-translational changes in proteins and test conditions of two-dimensional electrophoresis, whereby proteins can be separated by their molecular-weight and isoelectric-point.

Accordingly, a given protein from different sources can be presented with slightly different molecular weights and isoelectric points. As Dr. Getzenberg also attests, those skilled in the field can recognize when such variation is slight or significant, which enables the field to identify proteins with reasonable precision, notwithstanding the aforementioned variations in molecular-weights and isoelectric-points. By the same token, even without the recitation of “about,” as mentioned above, claims 1 and 17-24 accommodate slight variations in the molecular-weights and isoelectric-points recited.

II. Priority

The Examiner objected to a claim for priority to U.S. Provisional Application No. 60/041,860, filed on April 8, 1997, because the document allegedly does not provide support for nuclear matrix proteins of “about” a certain molecular weight and isoelectric point. Office Action, page 2.

Without acquiescing to the merits of the Examiner’s objection, the term “about” has been deleted from claims 1 and 17-24, as explained above. Applicant therefore requests that the objection be withdrawn.

III. Claim Rejection – 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1 and 17-24 for an alleged failure to set forth the subject matter that Applicant regards as his invention. Office Action, pages 3-4 (referring to pages 4-5 of the Office Action filed on January 4, 2007). The Examiner urges “about” is indefinite because “it cannot be determined if the same proteins or different proteins are being claimed in cases which the ranges would be reasonably be expected to overlap.” *Id.*, page 4.

Without acquiescing to the merits of the Examiner’s objection, the term “about” has been deleted from claims 1 and 17-24, as described above. Applicant also directs the Examiner to the Getzenberg declaration, discussed above. The declaration evidences that, contrary to the Examiner’s statement above, one skilled in the art can determine whether a given protein falls within the scope of the claims. As Dr. Getzenberg declares in paragraphs 7-9, two-dimensional electrophoresis is a widely accepted method of identifying proteins. This is exemplified in Exhibit 1 attached to the declaration. The presence of variations due to post-translational changes or test conditions, as described above, does not prevent one skilled in the art from identifying proteins because there are widely accepted techniques available to determine whether the variations are slight or significant. As explained in paragraph 9, triangulation is a technique that uses “surround spots” as landmarks to determine whether gel conditions caused a shift in protein spots between gels. Another method Dr. Getzenberg describes is computational geometry. Both of these methods have been evidenced in the literature, as exemplified by Exhibits 2 and 3, attached to the declaration.

Thus, the skilled person One skilled in the art has the means to determine whether variations in molecular-weight and isoelectric-point are slight or significant. Thus, the skilled artisan can readily recognize whether a particular protein falls within the scope of the claims which, as discussed above, accommodates slight variations in the molecular-weights and isoelectric-points recited.

IV. Claim Rejection – 35 U.S.C. § 112, First Paragraph – Written Description

The Examiner rejected claims 1 and 17-24 for an alleged absence of adequate written-description support for nuclear matrix proteins having molecular-weights and isoelectric-points not explicitly recited in the claims. Office Action, pages 3 and 4.

Although not acquiescing to the merits of the Examiner's rejection, Applicant has deleted "about" from claims 1 and 17-24, as noted above. Applicant submits that the claims satisfy the written description requirement, and he requests withdrawal of the rejection.

V. Claim Rejection – 35 U.S.C. § 103(a)

The Examiner rejected claims 1 and 17-24 over Konety *et al.*, *Journal of Urology* 159: 1359-63 (1998) in view of Ausubel et al., *SHORT PROTOCOLS IN MOLECULAR BIOLOGY* 3rd ed., pages 10/33-10/35). For reasons advanced above, however, the present application properly claims and benefits from priority to the '860 provisional application, filed on April 8, 1997. Accordingly, Applicant submits at least the primary reference, Konety *et al.*, is not citable as prior art in this context. Applicant therefore requests withdrawal of the rejection.

VI. Claim Rejection – 35 U.S.C. § 102(b)

The Examiner rejected the claims for alleged anticipated by Getzenberg, WO 98/45432. Yet, because the application has an effective filing date of April 8, 1997 (see above), the cited PCT application does not qualify as citable prior art. Accordingly, withdrawal of the rejection is warranted.

CONCLUSION

Applicant submits that the present application is in condition for allowance, and he requests an early indication to this effect. Examiner Reddig is invited to contact the undersigned directly, should he feel that any issue warrants further consideration

Respectfully submitted,

Date 19 December 2007

By S. A. Bent

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5404
Facsimile: (202) 672-5399

Stephen A. Bent
Attorney for Applicant
Registration No. 29,768

The Commissioner is hereby authorized to charge any additional fees, which may be required under 37 CFR §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, then Applicant hereby petitions for such extension under 37 CFR §1.136 and authorizes payment of the relevant fee(s) from the deposit account.